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10/804,458

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EXAMINER

PICKETT, JOHN G

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/804,458
Filing Date: March 19, 2004
Appellant(s): WOOD ET AL.

Royal W. Craig
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 20 March 2009 appealing from the Office action mailed 20 October 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 2003/0106819 A1	Bennett	6-2003 [102(e) 12-2001]
US 6,256,922 B1	Jones et al.	7-2001
US 5,431,970	Broun et al.	7-1995

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Bennett** (US 2003/0106819 A1; available under 35 USC 102(e)) in view of **Jones et al** (US 6,256,922).

Claim 1: Bennett discloses a long gun case in Figure 4. As Bennett specifically states like numerals indicate like elements (paragraph [0011]), the notations of Figures 1-3 will be used to denote the features of Figure 4. Accordingly, Bennett discloses an outer shell 26, a padded inner liner 28. Although Figure 3 shows the film 26 on the exterior surface, paragraph [0011] specifically states that the padding 28 is located on the inner surface. Bennett is formed by folding over a sheet and sewing the edges closed. Bennett uses a double stitching and may be considered "reinforced" around a peripheral seam. Bennett discloses an end opening and first fold-over flap 14 movable

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to close the end opening. Bennett discloses all limitations claimed by the applicant except for the fabric outer shell and the sidelong access opening.

Jones is in applicant's field of endeavor and teaches a fabric material (see Col. 4: 30-33). It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the outer shell of Bennett in a fabric material in order to have a sturdy, lightweight casing. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. One of ordinary skill in the art would have reasonably expected success since the layers of Bennett are connected by adhesive (paragraph [0012]), which is fully capable of operating with a fabric.

Further, Jones teaches a sidelong opening covered by a flap (see Figure 1, portions denoted by numbers 100, 200, 50, 60, 90. See also Figure 7). Jones teaches this opening for access to such features as the shell insertion portion or magazine insertion portion (see e.g. Col. 2: 43-48). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the case of Bennett with sidelong openings and fold-over flaps at the rear and mid portion of the case in order to have access to the rifle butt, shell insertion portions, or magazine insertion portions. The flaps of Jones are of unitary construction with the casing and therefore would be considered continuous (Figure 7). Access to the butt would be desirable since rifles sometimes have special features on the butt portion (e.g. a compass or compartment).

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One of ordinary skill in the art would have reasonably expected success since both cases are made in a similar manner.

Once modified with a sidelong opening at the rear and mid portions, Bennett-Jones would have a conjoined sidelong and end access opening and be fully capable of being turned inside-out. Turning the item inside-out is considered an intended use.

Claim 2: Both Bennett and Jones disclose closure flaps attached by hook-and-loop fasteners (Bennett 22 and Jones 160).

Claim 3: Jones is evidence that a woven fabric was known in the art (see Col. 4: 30-33). To replace the non-woven liner of Bennett with a woven liner would have been obvious to one of ordinary skill, based upon the desired strength of the liner. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Further, Bennett discloses liner 28 impregnated with rust inhibitors (paragraph [0016]) and it would have been obvious to include this feature in the combination in order to protect the retained firearm from rusting.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett-Jones as applied to claim 1 above, and further in view of Broun et al (US 5,431,970; previously provided).

Bennett-Jones, as applied to claim 1 above, discloses the claimed invention except for the middle layer of padding.

Broun is in applicant's field of endeavor and teaches a tri-layer protective material for gun cases (e.g. Figure 3), where the middle layer 14 is made of foam (i.e. padding) to protect against impact and abrasion. The padding also provides for flotation (Col. 4: 49-53). To modify the case of Bennett-Jones with an additional middle layer as taught by Broun would have been obvious to one of ordinary skill in the art for the purpose of additional impact resistance and/or flotation.

(10) Response to Argument

Appellant argues independent claim 1 and the combination of Bennett and Jones.

The initial argument is that the non-woven fabric 28 of Bennett is not "padding" as asserted by the examiner. Appellant argues that item 28 is never referred to in the disclosure of Bennett as "padding" and that the specific purpose of item 28 as presented by Bennett is to retain applied gun oils or lubricants. Appellant argues that item 28 is a "thin" felt or non-woven polypropylene. The examiner respectfully disagrees with this position.

Claim 1 specifically requires a "padded inner liner" (line 2). Appellant's own disclosure (Spec. at page 6, lines 16-18) states that "(t)he inside fabric 7 serves as a padded liner for the outside fabric 6, and is preferably a soft absorbent material such as a tufted cotton bound by a fabric facing for enveloping the gun." It would appear from appellant's own disclosure that a "soft absorbent material" would meet the appellant's

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definition of "padded inner liner"; it is respectfully asserted that Bennett's needle punched felt material would meet this definition.

As specifically indicated in paragraph [0014] of Bennett, fabric 28 is preferably a needle punched felt. And as shown in Figure 3 (Note: numbers 26 and 28 have been reversed in the figure; paragraph [0011] specifically indicates that item 28 is located on the inner surface), item 28 is significantly thicker than item 26. Given this greater thickness and felt material, the examiner contends that item 28 may be considered the claimed "padded inner liner". Although the Bennett reference does not use the term "padding", the prior art is not required to use the applicant's terminology. "What's in a name? That which we call a rose By any other name would smell as sweet." William Shakespeare. During patent examination, the pending claims must be given the broadest reasonable interpretation consistent with the specification. *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Prater*, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969). In applying the prior art, the claims should be construed to encompass all definitions that are consistent with applicant's use of the term. See *Tex. Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202, 64 USPQ2d 1812, 1818 (Fed. Cir. 2002).

Appellant's argument that the examiner is asserting that all non-woven fabric is inherently padding misrepresents the examiner's position. The examiner has made no such assertion for all non-woven fabrics; the examiner's position is, and has been limited to the Bennett reference.

Appellant's next argument is that neither Bennett nor Jones pursue the Appellant's stated goal and that the Examiner has not articulated any motivation for one skilled in the art to attempt the combination for the stated goal.

With respect to the appellant's stated goal, the reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. See, e.g., *In re Kahn*, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)

As to the articulated reason for combination, it is respectfully asserted that the rejection of 20 October 2008 clearly presents the reasons for combining the references.

As stated in the rejection:

Jones teaches a sidelong opening covered by a flap (see Figure 1, portions denoted by numbers 100, 200, 50, 60, 90. See also Figure 7). Jones teaches this opening for access to such features as the shell insertion portion or magazine insertion portion (see e.g. Col. 2: 43-48). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the case of Bennett with sidelong openings and fold-over flaps at the rear and mid portion of the case in order to have access to the rifle butt, shell insertion portions, or magazine insertion portions. The flaps of Jones are of unitary construction with the casing and therefore would be considered continuous (Figure 7). Access to the butt would be desirable since rifles sometimes have special features on the butt portion (e.g. a compass or compartment). One of ordinary skill in the art would have reasonably expected success since both cases are made in a similar manner.

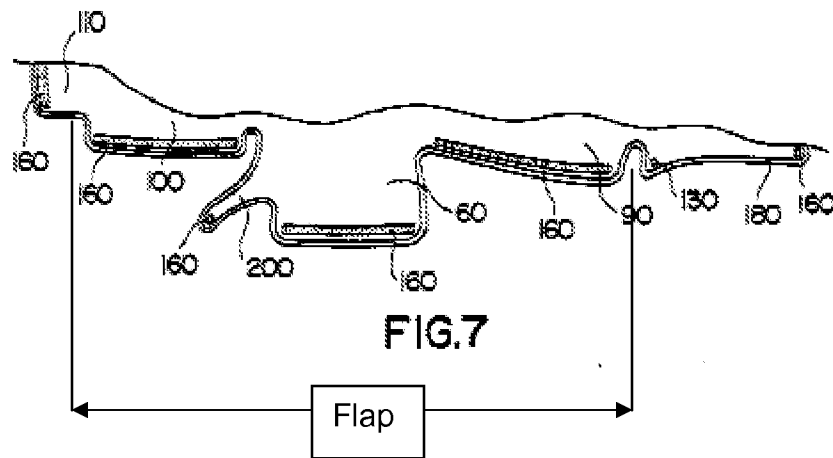
The secondary reference, Jones, provides the requisite motivation for combining the references, namely access to the different portions of the retained rifle. The feature of inversion for cleaning is an intended use that the combined Bennett-Jones case would be fully capable of performing since the combined case would be made of the same

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material and arranged in the same manner. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Appellant's next argument is that Jones does not present "a single sidelong opening/flap to envelope and protect a firearm." (Brief at page 7, line 5). The examiner contends that the appellant is arguing significantly more than claimed.

Claim 1 recites, "a second continuous foldover flap movable between an open position and a closed position releasably secured over said sidelong access opening to prevent access to the fabric enclosure" (claim 1, lines 8-10). Claim 1 uses the open terminology "comprising". When read broadly, the claim does not appear to require a single second flap, nor does it require the second flap to cover the entire sidelong access opening. The flap merely needs to close the opening, which flap 100 (or even flaps 60 and 90) of Jones would do, and be movable between an open and closed position. Even assuming, *arguendo*, that the claim requires a single flap, the term flap is a broad term, and the portion of Jones presented below could be considered a flap (see below).



The appellant's next argument contends that Jones discloses distinct side and end flaps/openings and not the elongate enclosure permanently closed along one side and end and defining conjoined sidelong and end access openings.

While the examiner agrees that Jones does not disclose the permanently closed end, it is respectfully noted that this feature is found in the base reference, Bennett. The argument that Jones fails to disclose all of the claimed features blurs the distinction between sections 102 and 103 of Title 35, United States Code. When considered together, the Examiner contends that the combined teaching renders the claimed invention obvious.

As to the argument concerning the conjoined sidelong and end openings, the Examiner respectfully disagrees with the appellant's position. Appellant points to Figures 1 and 10 to show distinct openings, yet these figures merely show the assembled device. As shown in Figure 7, end flap 110 and flap 100 are not separated by any structures and therefore constitute a conjoined end and side opening.

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Appellant's final argument is that the combined references fail to teach turning the casing inside-out. The turning inside-out feature is recited using the functional "whereby" statement and does not require any additional structures. The feature of inversion for cleaning is an intended use that the combined Bennett-Jones case would be fully capable of performing since the combined case would be made of the same material and arranged in the same manner.

Appellant does not separately argue claims 2-4 and states that claims 2-4 stand or fall with claim 1.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/J. Gregory Pickett/
Primary Examiner, Art Unit 3728

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